

Serial No.: 09/121,239
Filed: July 23, 1998
Group Art Unit: 1635

AMENDMENT
Docket No. GP091-02.UT

Remarks

Claims 1-3, 5-10, 12, and 14-26 are pending. All of the claims stand rejected, but claims 1-3, 6-10, 12, 14-18, and 21-26 were considered to be free of the prior art. The specification has been objected to by the Examiner. The drawings filed 23 July 1998 have been approved.

In this amendment, claims 1, 3, 5, 9, 18, 20-23 and 26 have been amended, claim 19 has been canceled, and new dependent claim 27 has been added. Claim 27 is for the embodiment described in Example 4 (e.g., see page 31, lines 8-16). The specification has been amended to insert references to SEQ ID Nos in the descriptions of the drawings for Figures 2 and 3, as appears elsewhere in the specification (see page 21, line 14 to page 22, line 1). No new matter has been added by these amendments. Entry of this amendment and reconsideration of this application is respectfully requested.

Amendments in the Specification

Amendments to the "Brief Description of the Figures" section, at page 13, lines 2-15, insert the SEQ ID Nos of the sequences illustrated in FIG. 2 and FIG. 3. Amendments to the Abstract, at page 48, delete the first sentence, change the sentence structure of and insert "*bcr-abl*" in the second sentence.

Applicants have presented these amendments in replacement paragraphs showing the changes relative to the original specification. Applicants believe that these amendments comply with the format that the Office plans to adopt in July 2003 by revision of 37 C.F.R. 1.121, and that these changes correct the informalities noted in the office action. Therefore, applicants respectfully request entry of the amendments and withdrawal of the objections to the specification.

Rejections under 35 U.S.C. § 112

Claims 1-3, 5-10, 12, 14-18 and 21-26 stand rejected under 35 U.S.C. § 112, first paragraph because the Examiner objected to the terms "*abl-specific*", "*bcr-specific*", "*bcr-derived*", "derived from a *bcr* sequence" and "derived from an *abl* sequence" for which the Examiner found no explicit definitions in the specification. Applicants respectfully submit that "*abl-specific*" and "*bcr-specific*" as used in the

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disclosure would be understood by one skilled in the art when read in view of the specification, e.g., at page 13, lines 11-13 (and Figure 3), page 29, lines 25-29, page 30, lines 2-4, page 31, lines 14-16, page 32, line 29 to page 33, line 1, and Examples 4 to 6 (pages 30-35). The Examiner suggested that alternative language of the specification be used in the claims "to define the spacial orientation of the primer based on the location of the break-point junction" (page 4, lines 3-4). Following the Examiner's suggestion, Applicants have amended claims 1, 3, and 9 to include language provided in the specification, e.g., at page 9, lines 1-2, 5-11, and 17-19, and in original claims 1, 3 and 9, and illustrated in Figure 2. Dependent claim 5 has been amended to be consistent with amended claim 1. Claim 18 has been amended to delete the term the Examiner objected to, and to insert a clause referring to SEQ ID NO:25, which is supported by the disclosure at page 12, lines 26-29, page 13, lines 9-15, page 20, line 28 to page 21, line 13, page 21, lines 23-29, page 30, lines 4-7, page 32, lines 8-12, and illustrated in Figures 1C and 3. Claims 21, 22 and 23 have been amended to delete references to the terms the Examiner objected to, and to insert phrases in claims 21 and 22 that refer to the amplified sequences (i.e., amplified *bcr* sequence, amplified normal *abl* sequence). Support for these amendments is found at page 19, lines 1-2 and 21-24, page 21, lines 14-20, page 30, lines 22-25, and illustrated in Figure 2. Dependent claim 26 has been amended consistent with amended claim 22.

Applicants respectfully submit that these amendments respond to the Examiner's objections in paragraph 6 of the office action and that the claims reasonably convey to one skilled in the relevant art the inventions in possession of the inventors at the time the application was filed. Moreover, Applicants believe that the amended claims are consistent with the scope of the claims described in the Examiner's statement in paragraph 9 of the office action ("...free if the prior art since the closest prior art, Sooknanen et al., cited previously taught only use of *bcr-abl* hybrid primers, not *abl* or *bcl* specific primers.") Therefore, Applicants request allowance of claims 1-3, 5-10, 12, 14-18, and 21-26.

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Rejections under 35 U.S.C. § 102(b)

Claims 19 and 20 stand rejected under 35 U.S.C. § 102(b). Claim 19 has been canceled and claim 20 has been amended to depend from independent claim 6, which the Examiner indicated is free of the prior art. Therefore, Applicants request allowance of amended claim 20.

Conclusion

In view of the foregoing amendments and remarks, the Applicants respectfully submit that the amended claims are in condition for allowance. Accordingly, allowance of the application is earnestly solicited. The undersigned has made a good-faith effort to address all the points raised in this Office Action and to place the claims in condition for allowance. If minor matters remain that could be resolved by telephone interview, the Examiner is invited to contact the undersigned at the number below.

Applicants believe there is no fee due in connection with the filing of this Amendment. However, if Applicants are in error and a fee is required, please debit Deposit Account No. 07-0835 the appropriate amount.

Respectfully submitted,

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